

### REMARKS

The Examiner is thanked for the Office Action of November 28, 2006. This request for reconsideration is intended to be fully responsive thereto.

### AMENDMENTS IN THIS RESPONSE

Claim 1 was amended to comply with the Examiner's suggestion and to limit the specific function of the battery. This limitation is clearly described in Claim 4 and supported by the original specification, for example, between line 19, page 3 and line 19, page 4. No new matter has been added.

Claim 2 was amended to follow the structure of Claim 1 and for clarification purposes. No new matter has been added.

Claim 4 was cancelled.

### CLAIM SUGGESTIONS

The Examiner suggested that "...a second connector...for selectively and electrically connecting to the portable electrical apparatus..." raises confusion because it appears that the second connector is designed for connecting with the electrical apparatus, not portable electrical apparatus. The Applicant agrees with the Examiner, and the amended Claim 1 reads "...a second connector...for selectively and electrically connecting to the portable electrical apparatus...". No new matter has been added.

REJECTION – 35 U.S.C. 102 (Kim et al)

The Examiner rejected Claims 1, 2, 3, and 5 under 35 U.S.C 102(e) due to the cited prior art US7041400. The Examiner suggested that Kim et al. disclose a battery pack comprising a battery module (100), a first contact (300), a second contact (500), a controller (210), and a memory module (230), where the second contact is connected to a USB transmission interface (col. 4, line 25 and the first contact is connectable to a portable electronic apparatus.

Kim et al. discloses:

"a battery which has: a battery array (100), a microprocessor (210), a signal processor (240), a nonvolatile memory (230),

a host interface (300) for supplying power to a host and performing a SMART communication therewith,

an input/output port (500) for performing an interfacing operation between the host and microprocessor o download a control program and data from the host, and

a protection circuit (220) for protecting battery cells in the battery array from overcurrent or overvoltage".

On the other hand, the present invention discloses:

"a battery which has a memory (23), a transmission interface (24),

a first connector (21) to be connected to the portable electrical apparatus (10);

a controller (22) which is connected to the first connector for transmitting data; a memory connected to the controller for storing data;

a second connector (25) connected to the transmission interface for selectively and electrically connecting to the electrical apparatus such that when the first connector is electrically connected to the portable electrical apparatus the portable electrical apparatus is allowed to retrieve the data in the memory through the controller, and when the second connector is electrically connected to the electrical apparatus the electrical apparatus is allowed to retrieve the data in the memory through the transmission interface and the controller; and

a battery module (26) connected to the transmission interface to obtain electric power when the second connector is electrically connected to the electrical apparatus and transmit the electric power through the transmission interface to the battery module for storing".

The second connector of the present invention is different from the input/output port (500) of Kim et al. The input/output port (500) is connected with the host or may be a wired

communication interface such as USB. The input/output port (500) performs an interfacing operation between the host and microprocessor (210) to download a control program and data to be stored in the nonvolatile memory (230) from the host. See line 65, column 3 – line 3, column 4. Kim et al. states “[t]he above-described construction enables...to upgrade battery associated information and software stored therein through communication with the host without its disassembly. See lines 16-20, column 4.

On the other hand, the second connector (25) of the present invention is connected to the transmission interface (24) which may be connected to the portable electrical apparatus (10). When the first connector (21) is electrically connected to the portable electrical apparatus, the portable electrical apparatus is allowed to retrieve the data in the memory (23) through the controller (22). However, when the second connector is electrically connected to the electrical apparatus, the electrical apparatus is allowed to retrieve the data in the memory, regardless of the connection between the portable electrical apparatus and the first connector (21), through the transmission interface and the controller. Kim et al. is silent on this point and does not teach or suggest this limitation.

Furthermore, Claim 1 was amended to introduce more precise features of the battery which was described in the specification in detail. The battery module of the present invention is connected to the transmission interface to obtain electric power when the second connector is electrically connected to the electrical apparatus, and transmit the electric power through the transmission interface to the battery module for storing. Kim et al. is silent as to these features. No where in Kim et al. suggest or taught this limitation.

POSSIBLE REJECTION – 35 U.S.C. 103 (Against Claim 1 by Kim et al.)

However, the Examiner rejected this limitation under U.S.C. 103(a) by suggesting that the invention as a whole would have been obvious because the artisan would be motivated to modify the system of Kim et al. so as to allow battery recharging through the second contact.

Applicant wishes to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP §2141. This section states that to establish a prima facie case of obviousness, three basic criteria first must met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or reference when combined) must teach or suggest all the claim limitation.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

§2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP §2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal

argument and evidence presented by applicant and the citation of In re Soni for error in not considering evidence presented in the specification.

The concept of the electrical connection of the second connector as explained above as well as other features should be new because of the above reasoning. After viewing the present invention, to modify the conventional art, i.e., Kim et al. and general thought should not be allowed under MPEP§2141. The second connector is electrically connected to the electrical apparatus, the electrical apparatus is allowed to retrieve the data in the memory, regardless of the connection between the portable electrical apparatus and the first connector (21), through the transmission interface and the controller. Kim et al. is silent on this point and does not teach or suggest this limitation. Moreover, as the Examiner agreed, Kim et al. is silent as to the battery limitation added in the amended Claim 1.

The necessary motivation is not found in the prior art and the Applicant's specification may not be used as a teaching reference. In re Fritch, 23 USPQ 1780, 1784 (ed. Cir. 1992), it is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. Therefore, the presently claimed invention is both novel and non-obvious for one of ordinary skill in the art to achieve Applicants present invention by combining Kim et al. and general thought, and surely is patentable. Accordingly, it is most respectfully requested that this rejection be withdrawn.

REJECTION – 35 U.S.C. 103 (Against Claim 4 by Kim et al.)

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. The Applicant disagrees; however, Claim 4 was cancelled at this time and therefore the

rejection is moot.

#### CONCLUSION

Accordingly, it is submitted that amended Claims 1, 2 and dependent claims 3-5 define the invention over the prior art and notice to this effect is respectfully solicited. Applicant has either complied with all Examiner recommendations or has effectively argued against the Examiner's objections/rejections and believes that all currently pending claims are now in condition for allowance. No new matter has been added.

Should the examiner believe further discussion regarding the above claimed language would expedite prosecution he is invited to contact the undersigned at the number listed below.

Respectfully submitted,

/Tracy M Heims/

Apex Juris, pllc  
Lake City Center, Suite 410  
12360 Lake City Way Northeast  
Seattle, WA 98125  
Tel: 206 664 0314  
Fax: 206 664 0329  
Email: usa@apexjuris.com